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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,575	03/31/2004	Ilya Malyarov	2008P26174 US	4329
28524 7590 07/30/2007 SIEMENS CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 170 WOOD AVENUE SOUTH ISELIN, NJ 08830			EXAMINER WRIGHT, PATRICIA KATHRYN	
			ART UNIT 1743	PAPER NUMBER
			MAIL DATE 07/30/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/813,575	MALYAROV ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	P. Kathryn Wright	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's amendment filed June 7, 2007, is hereby acknowledged. Currently claims 1-17 are pending. Any rejection/objection not repeated herein has been withdrawn.

#### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." See for example, patent no. 5,637,275 at page 2, line 10. Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "transfer device" in claim 1 and "plurality of vessel receptacles" in claim 10, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicants will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the "transport device" in claim 1 and "plurality of vessel receptacles" in claim 10 are not disclosed in the specification. The specification does disclose a "transport mechanism" at page 8, line 20. For clarity it is requested that the "transport device" in the claims be changed to the --transport mechanism-- in the specification, or *vice-versa*.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As set forth in the previous Office action, the specification does not disclose a "plurality of vessel receptacles" for receiving each of the plurality of vessels, as recited in claim 10. This introduces confusion and uncertainty into the claims.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Babson et al. (US Patent no. 5,885,529).

Babson *et al* teach an analyte detection station for an automated immunoassay analyzer, comprising a reaction reading station which includes an oval luminometer chain 215a that rotates between an entry position at wash station 214 and a read position at a detector (photomultiplier tube (PMT)); (col. 8, line 31; Figs. 2a, 2b).

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The detector (photomultiplier tube 216a) is coupled with the read station for detecting radiant energy.

The analyzer of Babson includes a transport device 213b (chain) for transporting a plurality of vessels 27 through a defined path, each of the vessels containing at least one bound analyte and at least one compound for emitting radiant energy or color. The transport device transfers one of the plurality of vessels into the read station at the entry position.

The read station of Babson *et al* has a shield (i.e., shutter; not shown but disclosed at col. 9, lines 27-30) for shielding external radiant energy when at the read position. Thus, only radiant energy from one of the plurality of vessels is detected by the detector.

Regarding claims 2 thru 4, please note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed, (i.e., chemiluminescence, fluorescence, phosphorescence, etc.,) fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches *all the structural limitations* of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). While Babson *et al* do not explicit teach a detector that detects phosphorescence, such a limitation is merely an intended use, which the prior art would inherently be capable of doing. The only distinction between applicants' claims and the prior art is recited functional language. It is incumbent upon Applicants to show that the application disclosed by the prior art is not actually capable of performing such functions. See *In re Ludtke*, 169 USOQ 563 (CCPA 1971). Moreover, Babson *et al*

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explicitly teach fluorescent, radioactive, chemiluminescent detection (col. 1, lines 20-34 and col. 8, lines 40-64).

With respect to claim 6, the Examiner considers the read station oval luminometer chain 215a as "biasing" the test vessel a set distance from the detector when in the read position before the PMT.

With respect to claim 8, the motor of the transport device moves the transferred vessel to a disposal station (col. 8, lines 32-33.)

Regarding claims 10 and 11, the transport device is a continuous belt having teeth (i.e., receptacle vessels) that receive the plurality of vessels. The belt can receive the vessel at a plurality of locations.

With respect to claims 12-16, Babson *et al* teach an attenuation means (rotatable filter wheel) for attenuating light signals. The attenuation means is located between the read station (which includes the transport device 215a) and the detector, and can be set at any three attenuation positions (see col. 9, lines 21-49). The three attenuation positions include: an unattenuated position where light from the vessel can be read directly by the detector; an attenuated position where light from the vessel can be read by the detector through neutral density filter; and a dark position where no light from the vessel can be read by the detector.

Regarding claim 17, the detection station of Babson *et al* include a means for measuring dark counts (i.e., computer 12). The computer uses these values to calibrate "noise" in the PMT (col. 9, lines 44-49.)

***Response to Arguments***

10. Applicant's arguments filed June 7, 2007 have been fully considered but they are not persuasive. In response to the previous rejection of claim s1-5 and 7-17 as being anticipated by Babson et al (US Patent no. 5,885,529), Applicant merely states that Babson discloses a prior art analyzer that does not teach the novel read station and transport device as set forth in the claims. Thus, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited. Further, they do not show how the amendments avoid such references.

***Conclusion***

11. No claim is allowed.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright (f. k. a. Bex) whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pkw

  
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